

REMARKS

Claims 1-3 are pending in the application. Claims 1-3 were rejected under 35 U.S.C. §103(a), as described in pages 2-3 of the Office Action. Claim 1 is the only independent claim.

The exciting electric power control of claim 1 is required to be operable to “**receive processed signals from the signal processor and to generate, on the basis of the processed signals, an electromagnet exciting current for controlling the bearing device.**” Still further, claim 1 requires the signal processor to be provided “**in said laser body**” and the exciting electric power control to be “**separated from said laser body.**”

It is respectfully submitted that the Examiner failed to establish a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103.

Whenever rejecting a claim under 35 U.S.C. § 103, the official action must include, (1) a statement regarding the features of the invention set forth in Applicants' claims; (2) a comparison of the claimed features of the invention with the closest prior art reference or references; (3) an explanation of why the differences between the features of an Applicants' claimed invention and the closest counterparts in the prior art are such that the claimed invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made, and (4) sub-stantiation of that explanation with either evidence in the form of prior art references or sound scientific reasoning such that one may take official notice of it. See, for example, *In re Hughes*, 345 F.2d 184, 145 USPQ 467 (CCPA 1965); *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963). Indeed, whenever a claim is rejected under 35 U.S.C. § 103, the Examiner must "expressly make the three factual determinations required by Graham and consider objective evidence of obviousness before the legal conclusion of obviousness vel non is made." *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F2d 1367, 231 USPQ 91, 93 (Fed Cir. 1986)

In the present case, the rejection is under 35 U.S.C. § 103 and both of the references show or describe inventions other than the claimed invention. On the record there are differences between the prior art teachings and what is claimed. The Examiner has noted the differences but has not explained why, despite the differences, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. On the contrary, page 2 of the Office Action merely asserts that “it would have been obvious to one having ordinary skill in the art at the time that the invention was made to provide Sekiguchi et al. [sic] a signal processor as taught by

Hiromasa et al.” In the absence of an explanation supported by specific factual findings based on evidence or sound scientific reasoning, the rejection is merely conclusory in nature and is therefore improper.

Accordingly, even if a combination of the teachings of Nara in view of Hiromasa would have taught all of the limitations of independent claim 1, which it does not, as discussed below, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103. Specifically, the Examiner has failed to explain why, either with evidence in the form of prior art references or sound scientific reasoning, it would have been obvious to modify the teachings of Nara with the teachings of Hiromasa to arrive at the claimed invention.

In any event, even if the Examiner had established a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103, which he has not for the reasons discussed above, it is respectfully submitted that neither Nara et al. (Nara) nor Hiromasa et al. (Hiromasa), either singly or in combination, teaches the above-identified limitations.

As described on page 2 of the Office Action, Nara does “not disclose a signal processor.” Accordingly, it is respectfully submitted that Nara fails to teach an exciting electric power control **operable to receive process signals from the signal processor** and to generate, on the basis of the process signals, an electromagnet exciting current for controlling the bearing device, as required in independent claim 1. Further, because Nara fails to teach a signal processor, Nara fails to teach a signal processor that is **provided in a laser body**, as required in independent claim 1.

It is respectfully submitted that Hiromasa fails to teach the shortcomings of Nara such that a combination of the teachings of Nara in view of Hiromasa would teach that which is required in independent claim 1.

Page 2 of the Office Action asserts that Hiromasa teaches “a signal processor 80 (control part 80).” Nevertheless, as illustrated and discussed in Hiromasa, the control part 80 is in magnetic bearing assembly 70. It is additionally respectfully submitted, as described in Hiromasa, that any exciting electric power control is additionally in the magnetic bearing assembly 70. Therefore, each of the control part 80 and an exciting electric power control are in bearing assembly 70.

If the excimer laser device of Nara were modified to include the magnetic bearing device of Hiromasa, for some as-yet-determined-reason, the modified devices would comprise the excimer

laser device of Nara, with the magnetic bearings (12) being replaced with the magnetic bearing device of Hiromasa. As a result, the modified excimer laser device comprising the teachings of Nara and Hiromasa would include a control part (80 of Hiromasa) and an exciting electric power control within the same housing. It is readily apparent therefore, that such a modified device would fail to include a processor **in a laser body** and an exciting electric power control **separated from a laser body**.

Therefore the combination of the teachings of Nara in view of Hiromasa fails to teach a signal processor in a laser body and an exciting electric power control separated from a laser body.

For the above discussed reasons, it is respectfully submitted that a combination of the teachings of Nara in view of Hiromasa fails to teach that which is required in independent claim 1, within the meaning of 35 U.S.C. § 103.


In light of the above discussion, it is respectfully submitted that claim 1 is patentable over combination of Nara in view of Hiromasa within the meaning of 35 U.S.C. § 103, and request the rejection of claims 1-3 be withdrawn.

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

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